

Response Under 37 C.F.R. §1.116
Serial No. 10/771,391
Attorney Docket No. 042080

REMARKS

Claims 1-9 are pending in the above-identified application. Claims 1 and 4 are amended. Claim 3 is cancelled. No new subject matter is added. It is respectfully submitted that this Amendment is fully responsive to the Office Action dated October 5, 2005.

Claims 1, 2, and 6-9 were rejected under 35 U.S.C. §102(b) as anticipated by *Nishiguchi* (U.S. Pat. No. 5,461,261.)

A claim is anticipated only if each and every element, *arranged as required in the claim*, is found described in a single prior art reference. Here, claim 1 of the present invention sets forth a method of manufacturing a semiconductor device comprising, in the recited order, the steps of... heating the first metal to melt and coagulate the first metal; supplying a second metal into the openings on the coagulated first metal; (and) heating the first metal and the second metal to melt and coagulate the first metal and the second metal. Whereas, *Nishiguchi* fails to disclose the step of *heating the first metal to melt and coagulate the first metal* (wherein this step is performed before the step of “supplying a second metal into the opening on the coagulated first metal”.)

Moreover, this step is not inherent from the prior art, because in order for a step to be found inherent, the unstated element must exist as a matter of scientific fact and flow naturally from the elements expressly disclosed in the prior art reference. *Hughes Aircraft Co. v. U.S.*, 8 USPQ2d 1580, 1583 (Cl. Ct. 1988). The steps recited in the present application do not flow inherently from the elements expressly disclosed in *Nishiguchi*.

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Also, to expedite prosecution, Applicants amend claim 1 to incorporate the features recited in claim 3, which is not disclosed or suggested in *Nishiguchi* and/or *Nakata et al.* (U.S. Pat. No. 2004/0079194). That is to say, the first metal is such a metal that a volume thereof is increased when it is heated to be molten and coagulated. As commonly understood, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art..."[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). Here, the Examiner has failed to provide such a teaching. Accordingly, in view the above remarks, Applicants respectfully request that the Examiner allow independent claim 1.

Also, as claims 2 and 6-9 depend from independent claim 1, these claims should likewise be allowable by nature of dependency.

Claims 4 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Nishiguchi* in view of *Nakata et al.* However, claims 4 and 5 depend from independent claim 1 and should likewise be allowable by nature of dependency.

In view of the aforementioned amendments and accompanying remarks, Applicants respectfully submit that that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

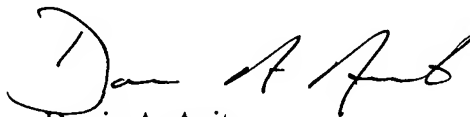
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If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in dark ink, appearing to read "Darrin A. Auito". The signature is fluid and cursive, with the first name "Darrin" being more prominent than the last name "Auito".

Darrin A. Auito

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